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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,259	10/31/2003	Takanobu Adachi	SHO-0029	9215

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WASHINGTON, DC 20036

EXAMINER

MOSSER, ROBERT E

ART UNIT	PAPER NUMBER
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3714

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/11/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/697,259

Applicant(s)

ADACHI ET AL.

Examiner

Robert Mosser

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 11/03/04, 5/26/04.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application
- ☐ Other: ____.

DETAILED ACTION

Claim Interpretation

APPARATUS CLAIMS MUST BE STRUCTURALLY DISTINGUISHABLE FROM THE PRIOR ART

While features of an apparatus may be recited either structurally or functionally, claims directed to an **apparatus must be distinguished from the prior art in terms of structure rather than function**. A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. (See *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987), *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997), *In re Swinehart*, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971), *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959), and MPEP 2114).

The instant case is replete with apparatus claims containing portions directed to the particular operation of the claimed apparatus rather than the physical structure of the apparatus. For instance claim 1 refers to the manipulation of a display object shown on the physical displays of the gaming device but this feature fails to further define the apparatus as the remainder of the claim establishes. If the Applicant intends for these limitations to be considered as possible distinguishing features of their claimed invention they must be appropriately presented within the confines of a method type claims. For

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the purposes of this action these limitations have been correlated to the prior art of record for the purposes of further prosecution.

Information Disclosure Statement

The information disclosure statements submitted May 26th, 2004 and November 3rd, 2004 have been considered and a copy said information disclosure statements including the Examiner's notation indicating their consideration is attached for the Applicant's records.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suganuma (US 7,121,945).

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Claim 1: Suganuma teaches a gaming device including a game result display means (Suganuma Figure 4), a beneficial state generating means for generating beneficial state for the player when specific game results are displayed on the display means (Col 9:66-10:3), a first reel display means (Element 6), and a second display means (Element 5). Suganuma additionally teaches control means for controlling the second display means so as to move a baseball (Figure 12c) from a first reel display to a second display area not including the first reel display area in a subsequent game (Column 7:6-30, Figures 9-10).

Suganuma however teaches the first reel display means in a more front side area then the second display means juxtaposed to the claimed apparatus where this configuration is presented in reverse. The transposition of the first reel display means and the second display means is understood to be a mere rearrangement of parts (See MPEP 2144.04 VI & In re Japikse, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950)). It would have been obvious to one of ordinary skill in the art at the time of invention to have interchanged the positioning of the first reel display and the second display means in order to reduce the over all height of the gaming apparatus or alternatively place the reel display at a height more convenient for repair and maintenance operations.

Claim 2: Suganuma teaches moving the display game information from the first reel display area to the second display area when the first reel display area concludes it's rotation (See Figure 10 steps 16-17 continued through Figure 9 step 2).

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Claim 3: Suganuma teaches modifying the light transmittance rate of the reel display (Col 8:57-67).

Claim 4: Suganuma teaches the display of second display at the periphery of the first reel display means and converting the display mode when game information is displayed in the first area (See figure 12c and 11a).

Claim 5: Suganuma teaches the gaming machine as taught above further including internal means for starting a game, determining the game outcome, and display the game outcome (See Figures 9, 10).

Conclusion

The following prior art is made of record and though not relied upon is considered pertinent to applicant's disclosure.

Loose et al (US 6,517,433) teaches a reel spinning slot machine with superimposed video image.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Mosser whose telephone number is (571)-272-4451. The examiner can normally be reached on 8:30-4:30 Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on (571) 272-6788. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

January 5th, 2007

RM

RM


MARK SAGER
PRIMARY EXAMINER